

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 1-24, 28, and 30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; rejected claims 1-4, 8, 9, 12-15, 19-22, 25, 26, 28, 30, 32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,697,865 to Howard et al. ("Howard") in view of U.S. Patent Application Publication No. 2003/0154180 A1 to Case et al. ("Case"); and rejected claims 5-7, 10, 11, 16-18, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of *Case*, and further in view of U.S. Patent Application Publication No. 2002/0138331 to Hosea et al. ("Hosea").

By the present amendment, Applicant amends independent claims 1, 14, 25, and 26. Claims 1-26, 28, 30, 32, and 34 remain pending.

**I. Rejection of Claims 1-24, 28, and 30 under 35 U.S.C. §101**

Applicant respectfully traverses the rejection of claims 1-24, 28, and 30 under 35 U.S.C. §101 as being directed to non-statutory subject matter. However, in order to advance prosecution, Applicant amends each of independent claims 1 and 14 to recite, for example, "generating, by using a processor of the computer system," "implementing, by using the processor," and "sending, by using the processor." Thus, independent claims 1 and 14, and dependent claims 2-13, 14-24, 28, and 30, are tied to a computer system that includes a processor. Accordingly, claims 1-24, 28, and 30 satisfy 35 U.S.C.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

§ 101, and Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 101 rejection.

**II. Rejection of Claims 1-4, 8, 9, 12-15, 19-22, 25, 16, 28, 30, 32, and 34 under 35 U.S.C. §103(a)**

Applicant respectfully traverses the rejection of claims 1-4, 8, 9, 12-15, 19-22, 25, 16, 28, 30, 32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of *Case*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6* (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145*. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103(a) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148

U.S.P.Q 459 (1966) . . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the difference between the claimed invention and the prior art." *M.P.E.P. § 2141(II)*. Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." *M.P.E.P. § 2141(III)*.

Independent claim 1 recites a method including, among other steps, implementing, by using the processor, an identity inspector tool; and

sending, by using the processor, a notification to the user to indicate that new context information is available for importation into the user profile, wherein the identity inspector tool provides:

a first option to the user to accept the new context information and initiate the importation of the new context information;

a second option to the user to change the new context information before the importation; and

a third option to the user to add additional information to the new context information before the importation.

*Howard* and *Case* fail to teach or suggest at least these elements of claim 1.

*Howard* discloses, in relevant part:

[A] permission (the "perform permission") gives a user the right to perform a specific function offered by a portal application. As suggested in the example shown in FIG. 2, the grant right of a permission (the "grant permission") gives a user the right to grant to other users the perform permission and the grant permission with respect to the application functionality associated with the permission. The grant and perform permissions are represented by flags in the profiles stored in the portal management database. As

shown in FIG. 2, user A's grant permission 100 enables user A to grant perform permission 102 to user B. (Col. 7, lines 43-53).

Thus, in *Howard*, user profiles are given permissions based on the permissions assigned to the user's company. As stated above, these permissions are given by enabling flags in user profiles. Such a disclosure, however, does not teach or even suggest "sending, by using the processor, **a notification to the user to indicate that new context information is available for importation** into the user profile," (emphasis added) as recited in claim 1. This is because *Howard* merely gives permissions by enabling flags based on flags in a company profile but does not send a "notification to the user to indicate that new context information is available for importation."

Moreover, even if enabling flags in a user profile in *Howard* could constitute the claimed "sending . . . notification," which it cannot, *Howard* still would not teach or suggest the claimed "identity inspector tool [that] provides a **first option** to the user to accept the new context information and initiate the importation of the new context information; a **second option** to the user to change the new context information before the importation; and a **third option** to the user to add additional information to the new context information before the importation," (emphasis added) as further recited in claim 1. This is because, as discussed on page 12 of the Office Action, personal relationship portal 27 in *Howard* grants permissions to a user profile based on the permissions of company profile, but *Howard* does not teach or suggest implementing an "identity inspector tool" that provides "a first option," "a second option," and "a third option" to a user.

Case does not overcome any of the above-noted deficiencies of *Howard* and does not teach or suggest “implementing, by using the processor, an identity inspector tool; and sending, by using the processor, a notification to the user to indicate that new context information is available . . . wherein the identity inspector tool provides: a first option . . . a second option . . . and a third option,” as recited in claim 1.

Accordingly, in view of the above-noted deficiencies, the Office Action has neither properly determined the scope and content of *Howard* and *Case* nor ascertained the differences between *Howard* and *Case* and the elements of claim 1. Further, the Office Action has not articulated a reason why one skilled in the art would have found the elements of claim 1 obvious. For at least the above reasons, the Office Action has not established a *prima facie* case of obviousness of claim 1. Thus, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdraw.

Independent claims 14, 25, and 26, while of different scope than claim 1, recite elements similar to those of claim 1 and are thus allowable over *Howard* and *Case* for at least reasons similar to those discussed above in regard to claim 1. The remaining claims rejected as being obvious over in view of *Howard* and *Case* are also allowable at least due to their dependence from one of the independent claims.

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

### **III. Rejection of Claims 5-7, 10, 11, 16-18, 23, and 24 under 35 U.S.C. §103(a)**

Applicant respectfully traverses the rejection of claims 5-7, 10, 11, 16-18, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable in view of *Howard*, *Case*, and *Hosea*, because a *prima facie* case of obviousness has not been established.

Claims 5-7, 10, 11, 16-18, 23, and 24 depend from one of independent claims 1 or 14. *Hosea* fails to remedy the above-noted deficiencies of *Howard* and *Case* with respect to independent claims 1 and 14. Consequently, any proper combination of *Howard*, *Case*, and *Hosea* does not present a *prima facie* case of obviousness with respect to claims 1 and 14, and therefore dependent claims 5-7, 10, 11, 16-18, 23, and 24 are allowable.

Accordingly, for at least the above-noted reasons, reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection is respectfully requested.

**CONCLUSION**

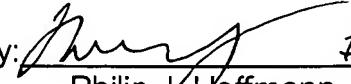
In view of the foregoing, Applicant requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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